



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Abuin *et al.* Group Art Unit: 1631

Application No.: 09/963,299 Examiner: J. Martinell

Filed: September 26, 2001

Atty Docket No.: LEX-0246-USA

Title: Novel Murine Polynucleotide Sequences and
Mutant Cells and Mutant Animals Defined Thereby

**AMENDMENT AND RESPONSE TO RESTRICTION AND ELECTION
REQUIREMENTS**

Commissioner for Patents
Alexandria, VA 22313

Sir:

The Examiner is respectfully requested to enter the following amendments. A response to the Restriction and Election Requirement mailed October 10, 2003 is also included herewith and the Examiner is respectfully requested to consider the remarks therein.

A Petition for an Extension of Time of one month to and including December 03, 2003 under 37 C.F.R. § 1.7, and authorization to deduct the fee as required under 37 C.F.R. § 1.17(a)(1) from Applicant's Deposit Account are included. Applicants believe no fee in addition to the fee for the extension of time is due in connection with this response. However, if any fees in addition to the authorized fee for the Petition for Extension of Time are required, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0892.

AMENDMENT

In the claims:

Please cancel claims 1-7, and 9 entirely without prejudice and without disclaimer, as drawn to non-elected inventions.

Please amend claim 8 so that the text of the amended claim reads as follows:

Claims 1-7 (cancelled)

Claim 8 (currently amended). An isolated murine embryonic stem cell line comprising an engineered mutation in a gene identifiable as encoding the polynucleotide sequence of SEQ ID NO[[S]]: ~~1-1,000~~ 36.

Claim 9 (cancelled).

RESPONSE

I. Restriction Requirement

The Examiner has determined that the original claims are directed to four separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1-6, drawn to polynucleotides and methods for making polynucleotides, classified in class 536, subclasses 23.5 and 23.1 and class 435, subclasses 6 and 91.1.
- Group II: Claims 7, drawn to computer methods for identifying polynucleotide sequences, classified in class 702 subclass 20.
- Group III: Claim 8, drawn to embryonic stem cell lines, classified in class 435, subclass 354; and
- Group IV: Claim 9, drawn to methods for producing antibodies, classified in 530, subclass 387.1.

II. Response to Restriction Requirement

In response to the Restriction Requirement mailed October 03, 2003, Applicants hereby elect without traverse to prosecute the claim of Group III (Claim 8), drawn to isolated murine embryonic stem cells, classified in class 435, subclass 354. Accordingly, Claims 1-7 and 9 are cancelled without disclaimer and without prejudice as drawn to non-elected inventions. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

III. Status of the Claims

Claims 1-7, and 9 representing the Group I, II, and IV inventions, respectively, have been cancelled without prejudice or disclaimer as drawn to non-elected inventions.

No claim within the Group III invention has been cancelled. In order to better define the invention of the elected Group III, the claim presently within the Group III invention has been amended. Applicants further elect SEQ. NO. 36 for sequence searching and examination.

Claim 8 is thus presently pending in the case.

IV. Support for the Claims

Support for amended Claim 8 can be found in the specification, *inter alia*, in Section 5 and originally filed Claim 8. In view of the clear support for the amended claim, the amendment is not deemed to constitute new matter.

V. Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Martinell have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

December 3, 2003

Date



Lance K. Ishimoto

Reg. No. 41,866

LEXICON GENETICS INCORPORATED
(281) 863-3333

Customer # 24231